

REMARKS

In an Office Action dated December 15, 2008, the Examiner rejected Claims 1, 2, 4-7, 18, and 19 under 35 U.S.C. §112, First Paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed. Applicant has carefully reviewed the Examiner's rejection, and comments as found in the Office Action dated December 15, 2008 and provides the following remarks regarding the Office Action. Claims 1, 2, 4 – 7, and 18 – 19 are pending in this application.

Claim Rejection – 35 USC §112, First Paragraph

The Examiner rejected Claims 1, 2, 4-7, 18, and 19 under 35 U.S.C. §112, First Paragraph, as failing to comply with the written description requirement. Applicant disagrees with the Examiner's understanding of the excess of amine as disclosed in the original specification and found in the previously presented claims. (See Table 1) The parts by weight ratios shown in this table clearly support the previous claim limitation that the amine is in "stoichiometric excess" relative to the branched epoxy functional silicone.

The support for the stoichiometric excess of amine can be found in Table 1 and other portions of the as-filed specification. The support for the previous amendment clarifying "stoichiometric excess of amine" is inherent in portions of the as-filed specification. Notably, in one portion of the specification it states, "... it is necessary have to have an adduct or excess amount of amine to keep the reactants liquid. This also means that the adduct or excess of amine reacts with the isocyanate prepolymer when making the final silicone modified polyurea." (Pg. 9, Lns. 27-30) To have an excess of amine available for reacting with the isocyanate prepolymer would require a stoichiometric excess of amine relative to the epoxy functional silicone for there to be an excess of amine available for reacting with the isocyanate prepolymer when making the silicone modified polyurea.

Another portion of the specification provides that it is preferable to have "... an excess of amine to keep the product liquid, as provided in Table 1." (Pg. 10, Lns. 6-7) Additionally, Table 1 provides several different examples of different types of amines being in excess by parts by weight relative to an epoxy functional silicone. The claims have been previously amended to clarify that the excess of amine is a stoichiometric excess, although the specification notes that the excess in these

specific examples is based on parts by weight. Rephrasing of these technical terms in the context of the specification does not constitute new matter. MPEP 2163.07

The as-filed specification may contain these amounts of amine in parts by weight and that does support the amounts being claimed as stoichiometric excesses of amine as would be commonly known by those skilled in the art. The MPEP provides, “[b]y disclosing in a patent application a device that inherently ... has a property, operates according to a theory ... a patent application necessarily discloses that ... theory or advantage, even though it says nothing explicit concerning it.” Additionally, “[t]he application may later be amended to recite the function, theory, or advantage without introducing new matter. The MPEP requires that to establish inherency, “... the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” MPEP 2163.07 It is clear from the cited portions of the specification noted above, that the excess of amount of amine relative to the epoxy functional silicone is a stoichiometric excess as would be understood by persons of ordinary skill in the art. This would clearly apply to any amine disclosed in the specification or otherwise contemplated by one of ordinary skill in the art. The Applicant respectfully requests the Examiner reconsider the continued assertion of this rejection.

Regarding the Examiner’s rejection that the previously amended limitation wherein the reaction product is not an intermediate product that does not require subsequent protonation, the Applicant requests that the Examiner reconsider this rejection as well. Clearly, the specification provides that the polyol prepolymer is not an intermediate product. The polyol prepolymer may be heated or cooled after being heated prior to mixing with other reactants. (Pg. 5, Lns. 5-15) There is nothing in the specification that describes that the polyol prepolymer is specifically an intermediate product. Yes, it may be used in the later reaction with an A-component polyisocyanate to ultimately formulate the epoxy functional polyurea, but it is a stable reaction product by itself. Additionally, the specification does not describe requiring a subsequent protonation step for stabilization, thus none is required for the reaction product. Thus, it is believed that this rejection has been overcome.

It is therefore believed that the Examiner’s rejections regarding Claims 1 and 18 have been overcome and are allowable under 35 U.S.C. §112, First Paragraph. Claims 2, 4-7, and 19 depend from and include all the limitations of amended Claims 1 and 18, respectively, thus they are also believed to be allowable under 35 U.S.C. §112, First Paragraph.

Application No. 10/648,934
Office Action dated December 15, 2008
Reply to Office Action dated June 15, 2009

Docket No.: 009608.0113PTUS

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance. Fees of \$555.00 for a three-month extension are believed to be due. However, if any other fee is due, please charge the deficiency to our Deposit Account No. 50-2816, under Order No. 009608.0113PTUS from which the undersigned is authorized to draw.

Respectfully submitted,

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